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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,927	07/15/2002	Luca Toldo	WEBER 3	9598

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EXAMINER

BRUSCA, JOHN S

ART UNIT PAPER NUMBER

1631

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/069,927

Applicant(s)

TOLDO ET AL.

Examiner

John S. Brusca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/13/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it is too long. 37 CFR 1.72(b) states that an abstract may not be over 150 words in length. Correction is required. See MPEP § 608.01(b).
2. For the purpose of examination the specification and claims are interpreted as being drawn to a method of iterative searching of a sequence database in which the sequences in the database that are determined to be matches to the query sequence in the first search are removed from the database prior to searching the database a second time with the query sequence.

### ***Claim Objections***

3. Claims 1-15 are objected to because of the following informalities:  
  
Each of claims 1-15 do not begin with an appropriate article such as “A” or “The.”  
  
In claim 1, part d), the phrase “separating out of those biosequences” should be amended to recite “separating out those biosequences.”  
  
In claim 13, line 1, the term “taht” should be amended to recite “that.”  
  
In claim 2, line 2, the phrase “in a matching” does not make grammatical sense.  
  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15 are indefinite for recitation in line 1 of claim 1 and line 3 of claim 4 of the phrase “potentially important” and for recitation in lines 1-2 of part f of claim 1 of the phrase “potentially increased importance” because the metes and bounds of the limitations are not clear. The rejection would be overcome by deletion of the phrase.

Claims 1-15 are indefinite for recitation in line 1 of part b) of claim 1 of the term “known”, for recitation in line 1 or part c) of claim 1 of the phrase “already known”, and for recitation in line 2 of part d) of claim 1 of the term “known” because it is not clear when or to whom the referred to items are known. The rejection would be overcome by deletion of the terms and phrase.

Claims 1-15 are indefinite for recitation in lines 2-4 of part b) of claim 1 of the phrase “functional importance” because the metes and bounds of the limitation are not clear. The rejection would be overcome by amending the claims to recite “function.”

Claims 1-15 recite the limitation "the already known species sequences of the species of interest" in line 1 of part c) of claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-15 recite the limitation "the given group of biosequences" in line 2 of part c) of claim 1. There is insufficient antecedent basis for this limitation in the claim.

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Claims 1-15 recite the limitation "the known species sequences" in lines 1-2 of part d) of claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-15 are indefinite for recitation of the phrase "from the group mentioned" in line 1 of part e) of claim 1 and recited in line 3 of part f) of claim 1 because it is not clear what group the phrase refers to. The rejection would be overcome by amending the claim to delete the phrase.

Claims 1-15 are indefinite for inclusion of part g) of claim 1 because part e) cannot be carried out before part c) since part e) requires the database produced in part d). The rejection would be overcome by deletion of part g) from claim 1.

6. Claims 2, 4, and 8 recites the limitation "the particular homologous biosequences" in lines 3-4 of claim 2 and line 2 of claim 4. There is insufficient antecedent basis for this limitation in the claim.

7. Regarding claims 2 and 8 the phrase "such as" in combination with the phrase "for example" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

8. Claims 5-7, 9-11 and 13 recite the limitation "the third databank" in line 1 of claim 5, line 1 of claim 9, and line 2 of claim 11. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 13 recites the limitation "the further databanks" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

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10. Claim 15 recites the limitation "the assigned group of biosequences" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### *Conclusion*

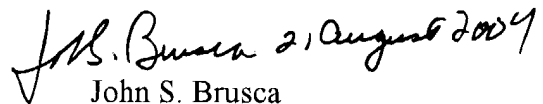
11. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center at (800) 786-9199. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is (571) 272-0714. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 21 August 2009  
John S. Brusca

Primary Examiner

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jsb